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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/745,262* | 12/20/2000 | Travis C. Riley | 3587/00-410 | 8352 |
| 7590 | 05/05/2005 | | EXAMINER | |
| William C. Norvell, Jr. BEIRNE, MAYNARD & PARSONS, L.L.P. Suite 2500 1300 Post Oak Boulevard Houston, TX 77056-3000 | | | KYLE, CHARLES R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |
| DATE MAILED: 05/05/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/745,262 | RILEY, TRAVIS C. | |
| | Examiner | Art Unit | |
| | Charles R Kyle | 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-52 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-52 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Rejections of **Claims 2, 3, 14, 19, 20, 31, 36 and 37** under 35 U.S.C. 112, second paragraph, of the prior office action are withdrawn based on Applicant's amendments.

Claims 1-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each Claim recites that real-time increments are designated by a customer. The concept of real-time is unclear because there is no specific definition of the concept. It generally suggests "very fast", but this does not delineate the metes and bounds of the Claims. Applicants seem to suggest in Remarks that transmission of pre-selected data is done at customer specified times, but this is not clear from the use of the phrase "real-time."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,721,783 *Blossman et al* in view of US 6,826,542 *Virgin et al* and further in view of *Using Microsoft Outlook 98*, hereinafter *Outlook 98*.

With respect to Claim 1, *Blossman* discloses the invention substantially as claimed, including in a method incorporating a financial institution computer system (Fig. 1) for extracting financial data within a data base in the computer system, formatting the data and transmitting the formatted data via electronic mail the steps of:

- a) Maintaining electronic information on financial accounts of a customer within said database in the financial institution computer system (Col. 7, line 61 to Col. 8, line 2; Col. 8, line 59 to Col. 9, line 7);
- b) Processing said electronic information within the database to identify and extract pre-selected data therefrom (Fig. 3, ele. 98b; Col. 10, line 44 to Col. 11, line 9);
- c) Electronically formatting said data for transmission to said customer via electronic mail (Col. 4, lines 10-39); and
- d) Transmitting the formatted data to a location designated by said customer via electronic mail (Abstract, Col. 6, line 66 to Col. 7, line 13; Col. 17, lines 39-56).

Applicant has added limitations reciting that the customer pre-selects data that is extracted to build an electronic file report and specifically argues this at page 22 of Remarks, emphasizing formatting into a customer preferred statement. *Blossman* does not specifically disclose this limitation, although *Blossman* does disclose that such reports are periodically created in accordance with pre-established customer preferences, suggesting the desirability of

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customer input in formatting. See Col. 5, line 66 to Col. 6, line 9. *Virgin* discloses these limitations as pre-selection by a customer of financial data (Col. 8, lines 5-19) and building an electronic report comprised of data extracted from the data pre-selected by the customer (Col. 9, lines 26-62). See also Abstract, Summary of the Invention and Col. 3, lines 54-67. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Blossman* with the data selection and formatting of *Virgin* because this would give control of statement information and appearance to the customer, as is specifically suggested by *Blossman* at the passage cited above.

As to the limitation where transmission occurs at times designated by the customer, Official Notice is taken that it was old and well known for customers to specify times at which to receive current financial information. For example, users of the *STAR* telephone banking system long had the ability to place a call to obtain updated statement summaries. This would have been an obvious modification of *Blossman* to improve convenience and timeliness of information for the customer. Additionally see *Blossman* at Col. 7, line 61 to Col. 8, line 2, where flexible scheduling is disclosed.

Blossman does not specifically disclose that the data is stored within and readout from the computer system of a user. *Outlook 98* discloses that email is stored on a user system at page 325 and readout at pages 321-322. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to include the storage and readout steps of *Outlook 98* because this would provide the final function necessary to present the formatted financial data to the user.

With respect to Claim 2, *Blossman* discloses a customer identification code for sorting at Fig. 5A “Tax ID/SSN 999-99-9999” for data formatted as a checking account at Figs. 5A-5C and Col. 14, lines 16-42.

Concerning Claim 3, *Blossman* discloses a mini trial balance for checking accounts at Col. 14, lines 16-25, Col. 14, lines 51-54 and Fig 5I. These are disclosed as generated on a predetermined time increment basis at Abstract.

With respect to Claim 4, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* is fundamentally concerned with email distribution of formatted financial data but does not specifically disclose the menu selections recited in Claim 4. The Examiner notes that these selections are common functions of email administration, and are disclosed by *Outlook 98* as follows:

- a) Customers - *Outlook 98* discloses addition of email recipients, in the case of *Blossman* customers, at pages 266-272.
- b) Options and Verify at pages 303-304. Verify is read as verification that a customer has received and/or read the email.
- c) Enable auto email at pages ~~351~~³¹⁵-316.
- d) Generate email at pages 296-298.
- e) Broadcast at pages 388-389.
- f) Help at page 19.
- g) Exit at page 492.

See also *Blossman* at pages 575-580 which discloses that menu selections can be customized as to arrangement. Applicant's claims recite no particular tree structure of the selections.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to provide the email administration selections disclosed by *Outlook 98* because this would allow the financial institution to specify structure and function for the financial data to be presented to customers.

As to Claim 5, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose a main menu selection of customers for data distribution. *Outlook 98* discloses a menu selection of persons to whom data is to be transmitted at pages 266-272. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to use the menu selection to designate customers to whom to send such data of *Outlook 98* because this would make use of a familiar and accessible email tool to direct financial data from the financial institution to customers.

Concerning Claim 6, *Blossman* discloses a mapping of a customer numerical identifier and an email address at Col. 15, lines 1-9.

As to Claim 7, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose a menu item for optionally charging for data transmitted to a customer. Official Notice is taken that it was old and well known to optionally charge customers for select banking services. For example, bank charges for maintenance of low balance checking accounts are commonly imposed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman*

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to provide a menu option to allow charging for certain services or items because this would help the financial institution to defray costs associated with the account.

As to Claim 8, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose confirmation of an email address through reading by the customer. *Outlook 98* discloses confirmation of an email address through reading by the customer at page 304. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to confirm valid email addresses as in *Outlook 98* because this would confirm that each email sent out was received/read at a valid email address.

As to Claim 9, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose suspending data transmission to the customer. *Outlook 98* discloses this limitation at page 361. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to provide a menu option to suspend data transmission to a customer because this would assure that only customers on an updated address list received financial information from the institution.

As to Claim 10, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose prohibiting advertising being sent to a customer. Official Notice is taken that it was old and well known to block advertisements at the time of the invention. For example, it was common to block “pop-up” advertisements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to prevent inclusion of advertisements in email from the institutions because this would avoid alienating customers with annoying ads.

With respect to Claim 11, *Blossman* discloses transmission of an interest rate calculation at Fig. 5A, "Interest Earned" and "Annual Percentage Yield Earned."

With respect to Claim 12, *Blossman* discloses customer name and email address at Col. 15, lines 1-9. *Blossman* does not specifically disclose an add/edit field in a menu to complete or change these items. *Outlook 98* discloses such menu functions at page 326 and pages 49-50. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to include the add/edit menu functions of *Outlook 98* because this would allow the financial institution to maintain up-to-date customer records.

Concerning Claim 13, *Blossman* discloses sorting transactions for a designated account of a customer identifier at Fig. 5B, "Checks in Number Order".

With respect to Claim 14, *Blossman* discloses establishment of an account for which processing is done based on designated time spacing at Col. 5, lines 16-26.

As to Claim 15, *Blossman* discloses account balance and account transactions at Figs. 5A-5C and Col. 14, lines 16-42.

With respect to Claim 16, *Blossman* discloses the invention substantially as claimed. See the discussion of Claim 1. *Blossman* does not specifically disclose verification of file availability and access. Official Notice is taken that it was old and well known at the time of the invention to verify file availability and access. For example, access permissions and file locking were used to preserve file integrity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to verify file availability and access because this would prevent unauthorized access to the files or modification of files by multiple persons.

With respect to Claim 17, see the discussion of Claim 4. *Blossman* does not specifically disclose broadcasting manually generated messages with financial data. Official Notice is taken that it was old and well known at the time of the invention to broadcast manually generated messages with financial data. For example, it was known to provide “inserts” or generalized information to all customers of an institution. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Blossman* to broadcast so as to provide generally applicable information to all customers.

Concerning Claims 18-34, they are system forms of Claims 1-17 and are rejected in a like manner. *Blossman* further discloses a computer system to perform the method steps of Claims 1-17 at Figs. 1, 3 and 4 and Cols. 7-14. Amendments to these Claims are analogous to those of Claims 1-17.

Concerning Claims 35-52, they are apparatus forms of Claims 1-17 and are rejected in a like manner as below. Amendments to these Claims are analogous to those of Claims 1-17.

With respect to Claims 35-47, see the discussion of Claims 1-14.

As to Claim 49, see the discussion of Claim 14.

Concerning Claims 48 and 50, see the discussion of Claim 15.

With respect to Claims 51-52, see the discussion of Claims 16-17.

Response to Arguments

Applicant's arguments with respect to claim 1 and similarly amended claims have been considered but are moot in view of the new ground(s) of rejection.

The submission by John C. Hughes was considered for its relevance to the Claims as amended and the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
April 25, 2005

Examiner Charles Kyle

